

REMARKS

A. BACKGROUND

The present Amendment is in response to the Office Action mailed April 29, 2009. Claims 1, 3, and 5-20 were pending and rejected in view of cited art.¹ Claims 8-9, 15, and 19 are cancelled, claims 1, 3, 6-7, 10, 12-13, 17-18, are amended, and new claims 21-23 are added. Claims 1, 3, 6-7, 10, 11-14, 16-18, and 20-23 are now pending in view of the above amendments.²

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

B. AMENDMENTS TO THE SPECIFICATION

The specification has been amended to update the previously identified attorney docket number with the serial number assigned to that application and to add patent numbers to the since issued patent applications.

C. PRIOR ART REJECTIONS

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejected claims 1, 3, 5, 8, 11-16, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,063,710 (*Takamoto*) in view of U.S. Patent No.

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should the need arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

6,511,489 (*Field*). Claims 6, 7, 9, 10, 17, 18, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takamoto* in view of U.S. Reissue Patent No. RE22,857 (*Ogburn*). Claims 8-9, 15, and 19 have been cancelled. With respect to the remaining claims, Applicant traverses the Examiner's rejection for obviousness on the grounds that the references – either individually or in combination – fail to teach or suggest each and every element of the rejected claims.

The Office Action admits, and Applicant agrees, that *Takamoto* "fails to teach a suture cutting blade positioned on the housing," (Office Action, page 2). However, the Office Action asserts that *Field* "teaches a suturing device with a common cutting blade positioned on the housing for cutting a suture (col. 7, lines 4-23)," (*id.*). Furthermore, the Office Action asserts that "Ogburn discloses that it is old and well known in the art to use a stationary suture cutting blade on the housing of a medical suturing device for the purpose of severing the suture after it has been applied to the wound," (Office Action, page 4). However, claims 1, 12, and 20 have been amended to recite, in part, "a suture cutting blade positioned" "on the movable handle," "on the inner surface of the proximal opening of the housing" and "on the finger grip of the housing," respectively.

The Office Action has not cited, nor has Applicant found, any portion of *Takamoto*, *Field*, or *Ogburn* that discloses, teaches, or suggests these elements. Rather, the Office Action merely asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a stationary suture cutting blade near the proximal end of the housing, on an outside of the housing, on a finger grip on the housing, or on a moveable handle of the device of *Takamoto*, in order to gain the advantage of being able to sever the suture after it has been applied to the wound, as taught by *Ogburn*," (Office Action, page 4). In support of this assertion, the Office Action further states that "In re Japikse held that claims that read on the prior art except with regard to the position of a claimed element were held unpatentable if shifting the position of the claimed element would not have modified the operation of the device," (*Id.*).

However, MPEP 2144.04(VI)(c) states that "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation

² Support for the claim amendments and/or new claim(s) can be found throughout the specification and/or drawings as originally filed.

or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.' Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)." Thus, in order to establish a *prima facie* case of obviousness based on *Takamoto* and *Ogburn* and using the reasoning behind *In re Japikse*, it would appear that there should be provided (1) a reason to combine *Takamoto* and *Ogburn* and (2) a motivation or reason "to make the necessary changes in the reference device."

Assuming *arguendo* that the assertion that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a stationary suture cutting blade near the proximal end of the housing, on an outside of the housing, on a finger grip on the housing, or on a moveable handle of the device of *Takamoto*, in order to gain the advantage of being able to sever the suture after it has been applied to the wound, as taught by *Ogburn*" provides a sufficient reason to combine *Takamoto* and *Ogburn*, Applicant respectfully submits that the Office Action has not provided a reason for modifying *Takamoto* and *Ogburn* to use "a stationary suture cutting blade near the proximal end of the housing, on an outside of the housing, on a finger grip on the housing, or on a moveable handle of the device of *Takamoto*." Specifically, the Office Action has not provided a reason for positioning "a suture cutting blade" "on the movable handle," "on the inner surface of the proximal opening of the housing," or "on the finger grip of the housing," as recited, in part, by claims 1, 12, and 20, respectively.

In fact, *Ogburn* teaches away from some possible modifications. For example, "transverse head 52" appears to be oriented perpendicular to "member or arm 11" so that "the suture may be cut by either a right-handed or a left-handed person with equal facility," (col. 4, ll. 3-10). Thus, changing the orientation of the transverse head 52 may render *Ogburn* unsatisfactory for its intended purpose of providing a device that allows "the suture [to] be cut by either a right-handed or a left-handed person with equal facility."

In view of *Takamoto*, *Field*, and *Ogburn*'s failure, whether alone or in combination, to disclose, teach, or suggest positioning "a suture cutting blade" "on the movable handle," "on the inner surface of the proximal opening of the housing," or "on the finger grip of the housing," as recited, in part, by claims 1, 12, and 20, respectively and because the Office Action has not provided both (1) a reason to combine *Takamoto*, *Field*, and *Ogburn* and (2) a reason for positioning "a suture cutting blade" "on the movable handle," "on the inner surface of the proximal opening of the housing," or "on the finger grip of the housing," as recited, in part, by claims 1, 12, and 20, respectively, Applicant submits that the Office Action has failed to set forth

a *prima facie* case for obviousness against claims 1, 12, and 20. Therefore, Applicant respectfully requests that the rejection of claims 1, 12, and 20 be withdrawn. As claims 3, 6-7, 10, 11, 13-14, 16-18, and 21-23 depend from claims 1, 12, and 20, these claims are also allowable for at least the same reasons as claims 1, 12, and 20. Therefore, Applicant respectfully requests the allowance of claims 3, 6-7, 10, 11, 13-14, 16-18, and 21-23.

D. CONCLUSION

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as provide the required motivation or suggestion to combine references with the other art of record.

For at least the foregoing reasons, Applicant respectfully submits that the pending claims are neither anticipated by nor made obvious by the art of record. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 21st day of July, 2009.

Respectfully submitted,

/Paul N. Taylor, Reg.# 57271/

PAUL N. TAYLOR
Registration No. 57,271
Attorney for Applicant
Customer No. 57360
Telephone No. 801.533.9800